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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/711,261	11/10/2000	John DeMayo	2580-019	6688

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EXAMINER	
CHAMPAGNE, DONALD	
ART UNIT	**PAPER NUMBER**
3622	

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/711,261	DEMAYO ET AL.	
	Examiner	Art Unit	
	Donald L. Champagne	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 July 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-32* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-32* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *10 November 2000* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed with an amendment on 11 July 2005 have been fully considered, but they are not persuasive. The arguments are addressed by a rejection rewritten for clarity and discussed explicitly at para. 10 below.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. At the third line from the end of each independent claim 1, 9, 21 and 24, "to convert" is indefinite: converting into what? This rejection can be overcome by replacing said, "to convert" with – to convert into one or more advertisements --. Support for this amendment is in the preamble of each of the four claims.

Claim Rejections - 35 USC § 102 and 35 USC § 103

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-2, 4-6, 9-10, 12-13, 21, 24 and 31 are rejected under 35 U.S.C. 102(e) as being as anticipated by Bull et al. (US005995943A).

7. Bull et al. teaches (independent claims 1, 9, 21 and 24) an apparatus and method for hyperlinking specific words in content or in text-containing files, or displayed in an application, to convert the words into advertisements, the method comprising: connecting a content provider server to the Internet, said content provider having content files to be displayed (col. 3 lines 31-34 and 66-67); providing an advertiser web page so as to be accessible over the Internet (the *Advertising DataStore* ***250***, col. 12 lines 32-34 and Fig. 2); and connecting an ad server (*advertiser's computer system* ***400***, col. 8 line 10 and Fig. 1) to the Internet, wherein the ad server provides *hot links* (col. 8 line 19-21), which reads on hypertext links or hyperlinks (Microsoft Press Computer Dictionary), to convert at least one existing word (e.g., *Holiday Inns on the West Coast*, col. 15 lines 39-42) present in a content file into one or more advertisements (e.g., an ad for *Hilton Inns on the West Coast*) by linking an Internet-enabled web browsing device (*network addressable interface device*, col. 3 lines 28-29) connected to the Internet to said advertiser web page (col. 15 lines 30-33). Bull et al also teaches the hypertext link at col. 3 lines 56-58. Bull et al. also teaches (claims 1 and 21) a terminal (*user access system* ***100***) for connection to the Internet.

8. Bull et al. also teaches that said word or phrase is advertiser-chosen. The reference teaches that the advertiser chooses the criteria by which the ads are placed (col. 8 lines 3-5 and 19-22), said advertiser-chosen criteria being used to choose said word(s) (col. 15 lines 24-29).

9. Bull et al. does not explicitly teach a hypertext anchor to said advertiser-chosen word. However, under the principles of inherency (MPEP § 2112.02), since the reference invention necessarily performs the method claimed, the method claimed is considered to be anticipated by the reference invention. As evidence tending to show inherency, the reference teaches ads hyperlinked (col. 3 lines 56-58 and col. 8 lines 19-21) to pages based on keywords in the content of that page (col. 15 lines 24-29). If a hyperlink is executed from text, there must be a hyperlink anchor at said text (Microsoft Press Computer Dictionary definition 2 of "anchor"). Since the hyperlink is executed by the appearance of the

keyword(s) or advertiser-chosen word or phrase, the anchor is, by definition, at said advertiser-chosen word or phrase.

10. Applicant argues repeatedly at pp. 11-14 that the reference does not teach that the ad server "provides a hypertext anchor to convert at least one existing advertiser chosen word present in a context file by linking said at least one existing advertiser chosen word to said advertiser web page". In detail from para. 7-9 above:

    The teaching of a hypertext anchor is inherent from the teaching of hypertext links or *hot links* at col. col. 3 lines 56-58 and col. 8 lines 19-21. See para. 9 above.

    The chosen word(s) present in a context file, *Holiday Inns on the West Coast*, are taught at col. 15 lines 39-42.

    Para. 8 above explains that said word(s) are advertiser chosen.

    The advertiser web page accessible over the Internet is taught as *Advertising DataStore **250*** (col. 12 lines 32-34 and Fig. 2), and linking to said advertiser web page is taught at col. 15 lines 30-33.

11. Bull et al. does not explicitly teach (independent claim 31) displaying a description of the advertiser web page when a mouse pointer is positioned over the hyperlink. However, under the principles of inherency (MPEP § 2112.02), since the reference invention necessarily performs the method claimed, the method claimed is considered to be anticipated by the reference invention. As evidence tending to show inherency, the reference teaches clicking on a URL (col. 14 lines 50-52), in order to access a Web page. The mouse pointer must inherently be positioned over the URL link in order to activate said link by clicking on it.

12. Bull et al. also teaches at the citations given above claims 2, 4-6, 10, 12 and 13.

13. Claims 3, 7, 11, 14-15, 22 and 25 are rejected under 35 U.S.C. 103(a) as being obvious over Bull et al. Bull et al. does not teach (claims 3, 11, 22 and 25) using a script to provide a hypertext anchor and (claims 7 and 14-15) using frames to display the content provider URL in a browser window. It was common, at the time of the instant invention, to use script to provide a hypertext anchor and display the URL of content in a browser window using frames. Because it is efficient to use common and well known practices, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings

of Bull et al. the use of script to provide a hypertext anchor and the use of frames to display the content provider URL in a browser window.

14. Official notice of this common knowledge or well known in the art statement was taken in the last Office action (mailed 2 August 2004, para. 11). This statement is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate. (MPEP 2144.03.C.).

15. Claims 8, 16, 23 and 26 are rejected under 35 U.S.C. 103(a) as being obvious over Bull et al. in view of Kirsch et al. (US006189030B1). Bull et al. does not teach linking to said advertiser web page using a tracking URL. Kirsch et al. teaches linking to said advertiser web page (*the external server* system, col. 7 lines 10-17) using a tracking server system (col. 5 lines 14-26), which reads on a tracking URL. Because Kirsch et al. teaches that tracking clicks is important (col. 2 lines 34-38 and col. 6 lines 60-61) and that the reference invention does so expediently, with minimum latency and visibility (col. 5 lines 33-37), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add Kirsch et al. to the teachings of Bull et al.

16. Claims 17-19, 27-29 and 31 are rejected under 35 U.S.C. 103(a) as being obvious over Bull et al. in view of Murray (US006061659A).

17. Bull et al. does not teach (independent claims 17 and 27) the advertiser compensating at least one of a content provider and an entity that selects said hypertext anchor. Murray teaches the advertiser compensating at least one of a content provider and an entity that selects said hypertext anchor (col. 8 lines 19-20). Because it facilitates the acceptance of advertising (col. 2 lines 22-24), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add Murray to the teachings of Bull et al.

18. Murray also teaches claims 18 and 28 at the citation given above.

19. Claims 19, 20, 29, 30 and 32 are rejected under 35 U.S.C. 103(a) as being obvious over Bull et al. in view of Murray and further in view of Kirsch et al.

20. Neither Bull et al. nor Murray teaches (claims 20 and 30) linking to said advertiser web page using a tracking URL. Kirsch et al. teaches linking to said advertiser web page (*the external server* system, col. 7 lines 10-17) using a tracking server system (col. 5 lines 14-26), which

reads on a tracking URL. Because that tracking clicks is important (col. 2 lines 34-38 and col. 6 lines 60-61) and that the reference invention does so expediently, with minimum latency and visibility (col. 5 lines 33-37), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add Kirsch et al. to the teachings of Bull et al. and Murray.

21. Kirsch et al. also teaches claims 19, 29 and 32 (col. 2 lines 29-38).

Conclusion

22. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

23. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.

25. The examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

26. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information

for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

27. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that "disposal or clarification for appeal may be accomplished with only nominal further consideration" (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.

28. Applicant may have after final arguments considered and amendments entered by filing an RCE.

29. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

Donald L. Champagne
Primary Examiner
Art Unit 3622

DONALD L. CHAMPAGNE
PRIMARY EXAMINER

30 September 2005